

Page 7 of 12
Application No. 09/489,600
Amendment "E"

REMARKS

The claims have been amended without adding new matter in order to correct minor informalities and to address other issues raised by the Examiner. Claims 1-6, 19, 20, 23 and 30-32 have been amended. Therefore, twenty (20) claims remain pending in the application: Claims 1-6 and 19-32. Reconsideration of claims 1-6 and 19-32 in view of the above amendments and remarks below is respectfully requested.

By way of this amendment, Applicants have made a diligent effort to place the claims in condition for allowance. However, should there remain any outstanding issues that require adverse action, it is respectfully requested that the Examiner telephone the undersigned at (858) 552-1311 so that such issues may be resolved as expeditiously as possible.

Information Disclosure Statement

1. The Examiner has requests that Applicants resubmit the missing references for consideration. Applicants are therefore submitting copies of the references previously submitting in Information Disclosure Statements (IDS) not considered by the Examiner by separate letter. These references include:

- copies of printouts of two Internet cites cited in Applicants' IDS submitted November 17, 2003;
- a Publication CHEN, HERNG-YOW et al., "MultiSync: A Synchronization Model for Multimedia Systems", IEEE Journal On Selected Areas In Communications, Volume 14, No. 1, January 1996, pp. 238-248, cited in Applicants' IDS submitted January 2, 2004; and
- eighteen (18) publications cited in Applicants' IDS submitted May 24, 2004.

Applicants respectfully request that the Examiner consider the above identified, re-submitted references.

2. Applicants further submitted an IDS on May 20, 2004, which has not been considered. Therefore, Applicants respectfully request that the Examiner further consider the references cited in the IDS submitted on May 20, 2004.

Page 8 of 12
Application No. 09/489,600
Amendment "E"

Claim Rejections - 35 U.S.C. §112

3. Claims 1-6, 19-21, 23, 24, 29 and 32 stand rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim that which Applicants regard as the invention. More specifically, the Examiner has objected to the use of "A method" in claims 2-6, and 31; and "the overlay" as recited in claim 32. Applicants have amended claims 2-6 and 31 to recite "The method"; and have amended claim 32 to recite "the overlay data" to provide accurate antecedent basis.

Further, the Examiner indicated that claims 1, 19, 20, 23 and 32 were indefinite for using the phrase "such as". It is respectfully submitted that Applicants could not find one instance of the use of the phrase "such as" in any of the pending claims. Alternatively, each of these claims recites the phrase "such that." It is clear from the use of the phrase "such that" that the text following this phrase are intended to be claim language and part of the claimed embodiments. Applicants respectfully submit that the phrase "such that" is not indefinite and does not render the claims indefinite. Applicants, however, have replaced the phrase "such that" with the word "where" to clarify the claims. These amendments were not made to overcome the Examiner's objection because the phrase "such that" was not indefinite. Therefore, Applicants respectfully request reconsider of these claims.

Claim Rejections - 35 U.S.C. §103

4. Claims 1-3, 5, 6, 19-26, 28-32 stand rejected under 35 U.S.C. § 103(a), as being unpatentable over U.S. Patent No. 5,808,662 (Kinney et al.) in view of U.S. Patent No. 5,991,374 (Hazenfield). Applicants respectfully submit, however, that the Kinney reference specifically teaches away from the methods of amended independent claimed 1, 22 and 30 and thus claims 1-6 and 19-32 are not obvious over the applied references.

More specifically, the Kinney reference describes a collaborative computer network for the use of editing films. Each workstation can simultaneously view the movie and make edits to the movie or control the playback of the movie as desired. This is advantageous as

Page 9 of 12
Application No. 09/489,600
Amendment "E"

it allows for the entire editing crew to make edits and participate in the editing process from remote locations. Furthermore, the system in the Kinney reference has a limited number of participants. Due to the limited number of people that would be taking part in the editing process, the system could function properly while still giving control to each of the participants, and allowing each workstation to generate data structures (e.g., see col. 5, lines 36-51 as recited by the Examiner in the subject Office Action) in controlling the playback.

In contrast, Applicants amended claim 1, for example, recites "wherein only the host can create the object" that is adapted to playback the event. Applicants' claimed methods provide for the simultaneous playback of an event. The claimed methods allow for only the host to create an object adapted to playback of the event. During the event, there can be thousands of participants all participating in the simultaneous playback. If each of the participants were able to control the playback, the system would not function properly as each user may want to stop or start the playback at different times. As the number of people participating in the playback event increases, the more of a problem letting the clients control the playback would become. By allowing only the host to generate the object adapted to playback the event, the host is thus able to host the event and control the simultaneous playback at the desired time without being interrupted by the client devices. The Kinney reference does not teach and instead teaches away from a method "wherein only the host can create the object," thus the rejection is overcome and claim 1 is in condition for allowance.

Furthermore, section 2143.01 of the Manual of Patenting Examining Procedure (MPEP) states:

"If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)."

Applicants submit it would not be obvious to modify the Kinney reference to provide a method "wherein only the host can create the object." Alternatively, such a modification to Kinney it would defeat the intended purpose of the Kinney reference. More specifically, the Kinney reference describes a system that is specifically designed to allow

Page 10 of 12
Application No. 09/489,600
Amendment "E"

multiple, remote users to simultaneously edit a movie, thus each participant must be able to control the playback of the movie. As is shown in Figs. 1 and 4 of Kinney, each playback system contains a playback control interface. To modify the Kinney reference to provide a system "wherein only the host can create the object," would destroy one of the intended purposes of Kinney which is to provide each playback system with the ability to control the editing process. Thus, the method of claim 1 would not have been obvious in view of the Kinney reference, nor would it be obvious to modify Kinney to achieve Applicants' claimed methods. As is such, Applicants respectfully submit the rejection is overcome and claim 1 is in condition for allowance.

Independent claims 22 and 30 have also been amended to include similar language as amended claim 1 reciting "only the host can create the object." Therefore, amended independent claims 22 and 30 are also not obvious in view of the Kinney reference for at least the reasons provided above.

Claims 1-6, 19-21 and 29 depend from claim 1, claims 23-27 depend from claim 22, and claims 31 and 32 depend from claim 30, and as such are also in condition for allowance for at least reason of their dependency upon allowable independent claims 1, 22 and 30, respectively.

5. Claims 4 and 27 stand rejected under 35 U.S.C. § 103(a), as being unpatentable over the Kinney reference in view of U.S. Patent No. 5,991,374 (Hazenfield), and further in view of U.S. Patent No. 6,161,132 (Roberts et al.). Applicants respectfully submit, however, that the combination of these references fails to teach or make obvious the methods of amended claims 1 and 22. Neither the Hazenfield or the Roberts references teach at least "creating an object at a host in response to the request, the object adapted to playback the event on a client apparatus simultaneous with the playback of the event on the remaining client apparatuses upon the receipt of an activation signal, wherein only the host can create the object"

Page 11 of 12
Application No. 09/489,600
Amendment "E"

as recited in amended claim 1. Therefore, the combination of these references does not teach or make the methods of claim 4 or 27 obvious.

Applicants further respectfully submit that one skilled in the art would not alter the Kinney reference to achieve the methods as claimed, irrespective of the Hazenfield or the Roberts references. As indicated above, the intended purpose of the Kinney reference is to allow multiple users to control the playback of the movie so that they can cooperatively edit the movie.

To alter the Kinney reference such that only the host could create an object would defeat the intended purpose because the users would lose control and could not cooperatively edit.

Therefore, one skilled in the art would not alter the Kinney reference to achieve the methods as claimed, and thus claims 4 and 27 are also not obvious over the applied references.

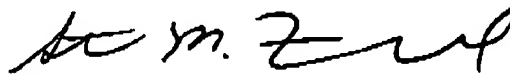
Page 12 of 12
Application No. 09/489,600
Amendment "E"

CONCLUSION

Applicants submit that the above amendments and remarks place the pending claims in a condition for allowance. Therefore, a Notice of Allowance is respectfully requested.

Respectfully submitted,

Dated: October 29, 2004



Steven M. Freeland
Reg. No. 42,555
Attorney for Applicants
(858) 552-1311

Address all correspondence to:
FITCH, EVEN, TABIN & FLANNERY
120 So. LaSalle Street, Ste. 1600
Chicago, IL 60603

Direct telephone inquiries to:
Steven M. Freeland
(858) 552-1311
San Diego, California Office of
FITCH, EVEN, TABIN & FLANNERY